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EXAMINER

LUONG, V

ART UNIT	PAPER NUMBER
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3682

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20

Serial Number: 09/115,764
Filing Date: July 15, 1998
Appellant: Michael Reasoner

MAILED

AUG 14 2000

John E. Carlson for
Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed May 25, 2000.

(1) Real Party in Interest.

The statement of the real party in interest is contained in the brief.

(2) Related Appeals and Interferences.

The statement of the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of claims.

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 4, 5, 17-21, 23-28 and 37-40.

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Claims 6-16, 22 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 30-36 are withdrawn from consideration as not directed to the elected invention originally claimed.

(4) Status of Amendments After Final.

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

(5) Summary of invention.

The summary of invention contained in the brief is correct.

(6) Issues.

The appellant's statement of the issues in the brief is correct.

(7) Grouping of claims.

Appellant's brief includes a statement that claims 4, 5, 17-21, 23-28 and 37-40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims appealed.

A substantially correct copy of appealed claims 4, 5, 17-21, 23-28 and 37-40 appears on pages 25-33 of the Appendix to the appellant's brief. The minor errors are as follows:

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(A) claim 17 is dependent upon claim 1 as seen in the Amendment A filed on June 7, 1999; and

(B) withdrawal claims 30-36 should not be presented in the Appendix.

(9) Prior Art of record.

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,339,783	Teichert	8-23-1994
4,598,809	Glover et al.	7-8-1986
5,119,689	Adams et al.	6-9-1992

(10) New prior art.

No new prior art has been applied in this examiner's answer.

(11) Grounds of rejection.

The following grounds of rejection are applicable to the appealed claims:

(A) Claim 27 is rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office action, Paper No. 15;

(B) Claims 17, 27 and 37-40 are rejected under 35 U.S.C. 112, second paragraph. This rejection is set forth in prior Office action, Paper No. 15;

(C) Claims 4, 20, 21, and claim 17, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Teichert. This rejection is set forth in prior Office action, Paper No. 15;

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(D) Claims 4, 5, 18-21, 23-26, and claims 17 and 27, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Glover et al. This rejection is set forth in prior Office action, Paper No. 15; and

(E) Claims 20 and 28, and claims 37-40, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Adams et al. This rejection is set forth in prior Office action, Paper No. 15.

(12) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(13) *Response to argument.*

A. Whether the Rejection of Claims 4 and 17 under 35 USC 102(b) is Proper?

Teichert'783

First, appellant summarily contended on page 6 of the Brief that with regard to Teichert'783, the core element 12 is *not movable inside* the conduit 54 because the core 12 is secured to the fitting 54 (col. 5, line 66). However, many of appellant's arguments fail from the outset because they are *not* based on the limitations appearing in the claims. *In re Self*, 213 U.S.P.Q. 1, 5 (CCPA 1982). In fact, a review of claim 4 shows that appellant merely calls for:

“a flexible motion transmitting core element (12) *movably supported in* said conduit.” (Emphasis, added).

In the instant case, appellant admitted that the core 12 of Teichert is secured to the fitting 54, therefore, the core 12 is movably supported in and by the fitting 54.

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For appellant's convenience, an example is given in the following. The core 12 and the fitting 54 are similar to a driver who is inside and drives an automobile. Although the driver is fixed relative to the automobile, however, both the driver and the automobile are moved relative to, e.g., a building on the road. Thus, the driver is *movably supported in the automobile relative to the building*. In the same manner, the core 12 is *movably supported in the fitting 54 relative to, e.g., the mounting plate 17* (Fig. 1).

It is well settled that the anticipation law requires a distinction be made between invention described or taught and invention claimed; it does not require that reference "teach" what subject patent application teaches; assuming that reference is properly "prior art," it is only necessary that claims under attack, as construed by court, "read on" something disclosed in reference, i.e., all limitations of claims are found in reference, or are "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 U.S.P.Q. 781, 789 (CAFC 1983).

In the case *sub judice*, since claim 4 does *not* narrowly claim that the core is moved *relative to the conduit, a fortiori*, appellant's broad language quoted above is "read on" or "fully met" by the core 12 which is movably supported in the conduit 54 relative to, e.g., the mounting plate 17 as explained above.

Second, using the same vein of arguments, appellant contended on page 7 of the Brief, *inter alia*, that: (a) in the Paper No. 15, the examiner interpreted the conduit sections as elements 36 and 58; (b) the elements 56 and 58 are parts of the fitting 54; and (c) since the core 12 is swaged or

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otherwise secured onto the core 12, consequently, the core 12 is not movably supported in the sections 36 and 58.

The examiner respectfully submits again that appellant's arguments are *not* based on the limitations appearing in the claims. Since the core 12 is swagged or secured to the section 58 as admitted by appellant, thus, the core is supported by the sections 36 and 58. In addition, since claim 4 does *not* narrowly claim that the core is moved *relative to the conduit, a fortiori*, appellant's broad language quoted above is "read on" or "fully met" by the core 12 which is movably supported in the conduit sections 36 and 58 relative to, e.g., the mounting plate 17 as explained above.

Third, appellant contended that the examiner's Exhibit I in Paper No. 15 is erroneous and appellant's Modified Exhibit attached to appellant's Amendment filed on September 20, 1999 (Paper No. 12) is correct.

The examiner respectfully submits that: (a) appellant's recitations such as "to shorten the overall length of said first and second conduit sections (14, 16)" in the claim merely denotes an intended use; and (b) appellant's drawings fail to illustrate this claimed feature as required under 37 C.F.R. 1.83.

It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use

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must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In the instant case, contrary to appellant's subjective determination, Teichert's structure is capable of performing the intended use as seen in Examiner's Exhibit I. The examiner follows the established rule that, during the prosecution, the claims should be given their broadest reasonable interpretation. *In re Pearson*, 181 U.S.P.Q. 641 (CCPA 1974).

On the one hand, using the drawings of Teichert, the examiner interprets the sections 36 and 58 of Teichert as the conduit sections. The distance L1 defined by the lengths of the elements 36 and 58 in Fig. 2A is shorter than the distance L2 defined by the lengths of the same elements 36 and 58 in Fig. 2B as seen in Examiner's Exhibit I. Meanwhile, appellant's Modified Exhibit is nonresponsive to the Examiner's rejection as required under 37 C.F.R. 1.111 because appellant subjectively changed the examiner's interpretation to define L1 as the length of the elements 36 and 58, *and the length of the gap between the left end of the element 36 and the abutment 46 in Fig. 2A*. Appellant's basis to add *the length of the gap between the left end of the element 36 and the abutment 46 in Fig. 2A* is unclear to the examiner when it is unreasonable to interpret this gap or air space as a conduit section.

The above analysis is based on the rule that a claimed invention may be anticipated or rendered obvious by a drawing in a reference, whether the drawing disclosure is accidental or intentional. *In re Meng*, 181 U.S.P.Q. 94, 97 (CCPA 1974); *In re Mraz*, 173 U.S.P.Q. 25 (CCPA 1972), and M.P.E.P. 2125.

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On the other hand, the examiner is mindful that absent any written description in the reference specification of quantitative values, the arguments based on measurement of Teichert's drawings are futile. *In re Wright*, 193 U.S.P.Q. 332, 335 (CCPA 1977). Therefore, assuming *arguendo* that the above analysis is futile, the examiner respectfully submits that the claims are still anticipated by Teichert since Teichert's is capable of performing the intended use.

Noted that the reference does not need to provide explanation about what artisan would know as evidenced by standard text book. *In re Opprecht*, 12 U.S.P.Q.2d 1235 (CAFC 1989). In the case at hand, using common sense or logical reasoning, one having ordinary skill in the art knows or has reasons to know that when the spring 38 is expanded to the left, i.e., from the position in Fig. 2B to the position in Fig. 2A, the core 12 is moved to the left with the fitting 54 and then stopped when the flange 56 of the fitting 54 is abutted with the coupling 22. Since the coupling 22 is fixed to the throttle lever 20 (Fig. 1, line 12 et seq., column 6), therefore, the coupling 22 and the lever 20 swings or pivots rearwardly to the left (Fig. 1). Consequently, the conduit sections 36 and 58 are also pulled rearwardly against the coupling 22 and simultaneously causes the *overall* length of the conduits 36 and 58 to be shortened as claimed.

Claim 4 is rejected for the reasons stated above.

Claim 17 adds the further limitation that the spring expands axially to bias together to shorten the *overall length* of the conduit sections. As explained above, spring 38 of Teichert expands axially as seen in Figs. 2A and 2B to bias together to shorten the *overall length* of the conduit sections as inherently shown in Fig. 1. The rejection of claim 17 is likewise maintained.

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Glover'809

First, appellant summarily contended on page 6 of the Brief that with regard to Teichert'783, the conduit sections of Adams are not shortened because the spring 20 pushes the conduit away.

The above arguments are apparently in conflict with the evidence presented in the record. Appellant ignored the description in lines 13-33 of column 4 of Glover wherein Glover explicitly describes that the sleeve or conduit section 7 is shortened. When the conduit section 7 is shortened, the conduit section 9 in the position shown in Fig. 3 is moved to the left until it engages the end of member 40 as seen in the position shown in Fig. 4 and described in lines 1-12 of column 4. Since the conduit section 9 is moved to the left, it is inherently shortened also. Consequently, the total overall length of both conduit sections 7 and 9 are inherently shortened as seen in Fig. 1.

Second, appellant averred on page 9 of the Brief that the sections 7 and 9 of Glover do not "interconnect." Appellant apparently disregarded the established rule that, during the prosecution, the claims should be given their broadest reasonable interpretation. *In re Pearson, supra*. In the instant case, if one compares Figs. 3 and 4 of Glover and appellant's Fig. 3, one would reasonably recognize that the conduits 7 and 9 of Glover are "interconnect" indirectly via the elements 20, 21, 40, 3, etc.

Third, appellant stated that appellant's Fig. 3 shows that the conduit section 16 is attached to the female member 20 as the end of the conduit 16 is received within a bore in female member 20. However, the examiner is mindful that appellant's claim 4 does not specifically claim so. More important, appellant apparently ignored Glover's disclosure. Indeed, Glover's Figs. 3 and 4 show

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that the conduit section 7 is attached to the female member 5 indirectly via the elements such as 20, 21, 31, 29, etc., as the end of the conduit 7 is received within a bore 25 in the female member 5.

Fourth, appellant insisted that Glover does not disclose the retainer for retaining the spring. The examiner respectfully urges appellant not to use “*ipsissimis verbis*” test that requires the same terminology in the prior art in order to find anticipation. *AKZO N.V. v. International Trade Commission*, 1 U.S.P.Q.2d 124, 1245 (CAFC)(footnote 11). Contrary to appellant’s conjecture, Glover teaches the so-called “retainer” 36 which acts as a seat for the spring 35 and retains the spring 35 in compression as seen in Fig. 4 of Glover. Glover’s flange 36 is the so-called “retainer” since it acts in the same manner as appellant’s retainer and Glover was under no obligation to use appellant’s terminology. It is well-settled law that an inventor is ordinarily permitted to use his or her own terminology as long as it can be understood. M.P.E.P. 608.01(g).

Fifth, appellant asserted that claim adds the further limitation that the spring expands axially to bias together to shorten the *overall length* of the conduit sections. As explained above, the spring 38 of Glover expands axially as seen in Figs. 3 and 4 to shorten the *overall length* of the conduit sections as inherently shown in Fig. 1 and described in column 4. The rejection of claim 17 is likewise maintained.

35 USC 112, Second Paragraph

Appellant proposes to amend the dependency of claim 17 from claim 1 to claim 4. However, appellant did not file any formal amendment after final. Therefore, claim 17 is legally dependent on claim 1, *a fortiori*, this ground of rejection is legally proper.

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B. Whether the Rejection of Claim 5 under 35 USC 102(b) is Proper?

Appellant asserted that the elements 30 and 31 of Glover are not locking members.

The above arguments lack proper foundation because appellant again uses "*ipsissimis verbis*" test that requires the same terminology in the prior art in order to find anticipation. *AKZO N.V. v. International Trade Commission, supra*. Contrary to appellant's conjecture, Glover teaches the so-called "locking members" 30 and 31. In fact, Glover's Figs. 3 and 4 show that when the members 30 and 31 are abutted against the tapered wall 29, the teeth 21 of the male member 20 are engaged with the teeth of the members 30 and 31, consequently, the male member 20 cannot move, i.e., the male member 20 is in a locked position to prevent the relative telescoping movement between the male (20) and female (5) members.

C. Whether the Rejection of Claim 18 under 35 USC 102(b) is Proper?

First, appellant strenuously repeated that Glover's adjustment components 5 and 20 do not interconnect the sections 7 and 9.

Appellant's semantic arguments again apparently disregarded the established rule that, during the prosecution, the claims should be given their broadest reasonable interpretation. *In re Pearson, supra*. In the instant case, Figs. 1, 3 and 4 of Glover show that the components 5 and 20 interconnect the conduits 7 and 9 of Glover via the elements 21, 31, 32, etc. The interconnection is summarized in the Abstract of Glover. On the other hand, common sense teaches that if Glover's adjustment

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components 5 and 20 do not interconnect the sections 7 and 9 as appellant alleged, the cable and sleeve connector of Glover would be inoperative for its intended purposes.

Second, appellant repeated that the overall length of the conduits 7 and 9 are not shortened. The examiner is mindful that the intended use statement in appellant's claims which are not even shown in appellant's drawings adds nothing to claims' patentability since it merely expresses necessary or inherent results of what is recited in the claims. *Texas Instrument Inc. v. International Trade Commission*, 26 U.S.P.Q. 2d 1018 (CAFC 1993). More over, contrary to appellant's subjective conjecture, lines 13-33 of column 4 of Glover describe that the sleeve or conduit section 7 is shortened. When the conduit section 7 is shortened, the conduit section 9 in the position shown in Fig. 3 is moved to the left until it engages the end of member 40 as seen in the position shown in Fig. 4 and described in lines 1-12 of column 4. Since the conduit section 9 is moved to the left, it is inherently shortened also. Consequently, the total overall length of both conduit sections 7 and 9 are inherently shortened as seen in Fig. 1.

The rejection of claim 18 is, therefore, maintained.

D. Whether the Rejection of Claim 19 under 35 USC 102(b) is Proper?

Appellant again semantically alleged that Glover's adjustment components 5 and 20 do not interconnect the sections 7 and 9. In view of judicial economy, the examiner respectfully refers to the explanation in claim 18 above.

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Second, appellant admitted in the last paragraph on page 13 of the Brief that *any adjustment that is made to conduit 7 is subsequently made to conduit 9 in the same direction*. In the instant case under litigation, the adjustment to Glover's conduit 7 is the shortening of the conduit 7. This shortening adjustment of conduit section 7 is subsequently made to conduit 9 in the same direction as admitted by appellant. Therefore, appellant admission is in consonant to examiner's explanation above, i.e., since both conduits 7 and 9 are shortened, their overall length is shortened as claimed.

The rejection of claim 19 is, therefore, maintained.

E. Whether the Rejection of Claims 20 and 21 under 35 USC 102(b) is Proper?

Teichert'783

Appellant again semantically alleged that Teichert's fitting 54 is not a "conduit section." In view of judicial economy, the examiner respectfully refers to the explanation in claims 4 and 17 above.

Second, appellant alleged that the fitting 54 and the stop 16 are both secured to the cable 12, the distance between the guide 40 and the fitting 54 can never change. However, appellant overlooked the fact the rejection interpreted the sections 36 and 58 as the conduits. The guide 40 is not interpreted as a conduit section as plainly seen in the Office action (Paper 15). Therefore, the argument about the guide 40 is immaterial and nonresponsive to the rejection.

For the reasons set forth above, this ground of rejection should be maintained.

Glover'809

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Appellant again semantically alleged that Glover's adjustment components 5 and 20 do not interconnect the sections 7 and 9. In view of judicial economy, the examiner respectfully refers to the explanation in claim 18 above.

Second, appellant admitted again on page 15 of the Brief that *any adjustment that is made to conduit 7 is subsequently made to conduit 9 in the same direction*. In the instant case under litigation, the adjustment to Glover's conduit 7 is the shortening of the conduit 7. This shortening adjustment of conduit section 7 is subsequently made to conduit 9 in the same direction as admitted by appellant. Therefore, appellant admission is in consonant to examiner's explanation above, i.e., since both conduits 7 and 9 are shortened, their overall length is shortened as claimed.

The rejection of claims 20 and 21 is, therefore, maintained.

Adams'809

Appellant insisted that Adam does not disclose a coil spring interacting between the adjustment components to bias the components together to shorten the overall length of the first and conduit sections as required by claim 20.

Appellant overlooked the fact that Adams explicitly states in the Abstract and lines 33-37 of column 3 that when the internal teeth 12 on the locking sleeve 11 are brought into engagement with the external teeth 18 on the sheath end-piece 14, the length of the Bowden cable sheath or conduit sections (*id.*, line 63 et seq., column 2 and see Exhibit II attached to Paper 15) is reliably fixed and held. In other words, Adams uses the spring 20 to eliminate the slacks in the conduit sections by bringing the two conduit sections close together as seen in Fig. 1. When the conduit sections of

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Adams are brought close together to eliminate their slacks, their overall length is simultaneously shortened to a fixed length as described.

In summary, the spring 20 of Adams is capable of performing appellant's intended use, thus, it meets the claim. The rejection of claims 20 and 21 is, therefore, maintained.

F. Whether the Rejection of Claims 23-27 under 35 USC 102(b) is Proper?

Glover'809

Appellant again semantically alleged that Glover's adjustment components 5 and 20 do not interconnect the sections 7 and 9. In view of judicial economy, the examiner respectfully refers to the explanation in claim 18 above. Further, using the same vein of arguments, appellant alleged that the elements 30 and 31 are not locking members. In view of judicial economy, the examiner respectfully refers to the explanation in claims 5 and 18 above.

35 USC 112, Second Paragraph

Appellant asserted that lines 4-8 of column 3 of appellant's specification describe an abutment upon assembly of the male 18 and female 20 members. However, appellant's claim 27 is not a process of assembly claim. More important, appellant's drawings do not show the claimed feature "abutment." To the contrary, Figs. 3, 4 and 6 plainly show that the locking member is *not* abutted with the spring 22. Therefore, the meaning of the terms such as "abutment" and "during assembly" in claim 27 is not understood in light of the drawings.

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Since the scope of the claimed subject matter such as “abutment” and “during assembly” cannot be determined by one having ordinary skill in the art as shown in appellant’s drawings, this ground of rejection should be maintained.

35 USC 112, First Paragraph

Appellant subjectively determined that it is easily visualized appellant’s assembly step by reading the description and by viewing the drawings.

At the outset, appellant’s assertion is apparently a self-serving statement or a conclusory statement in nature rather than factual evidence. In fact, the record is naked of any proof, affidavit or declaration to support appellant’s conclusion. One having skill in the art would have to perform undue experimentation in order to make/use the claimed invention since the specification fails to describe and the drawings fail to show, e.g., how the locking member is abutted with the spring as claimed. See *Ex parte Ohshiro*, 14 U.S.P.Q.2d 1750 (Bd. Pat. App. & Inter. 1989) (the drawings do not show the claimed piston that has a recessed channel formed therein). It is well settled that an expert’s opinion on the ultimate legal issue must be supported by something more than a conclusory statement. *In re Brandstadter*, 179 U.S.P.Q. 286, 194 (CCPA 1973) and *In re Buchner*, 18 U.S.P.Q.2d 1331, 1332 (CAFC 1991).

Second, the CAFC in *Martin v. Mayer*, 3 U.S.P.Q.2d 1333, 1337 (CAFC 1987) has long laid appellant’s arguments to rest. Indeed, the Court has emphasized that *the issue is not whether one skilled in the art would have been able to make the spring means or the like using knowledge of the art, but rather did appellant’s application sufficiently describe the spring means or the like. Section*

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112 does not require that the specification contains that which is known to those skilled in the art, but it does require specificity as to the claims limitations. It is “not a question of whether one skilled in the art *might* be able to construct the patentee’s device from the teachings of the disclosure . . . Rather, it is a question whether the application necessarily discloses that particular device.” *Jepson v. Coleman*, 136 U.S.P.Q. 647, 649-650 (CCPA 1963)(emphasis in original). In the instant case, although the assembly step is easily visualized to appellant as a matter of course, however, it is not easily to one having ordinary skill in the art when appellant’s drawings fail to comply with the requirements under 37 C.F.R. 1.83.

For the reasons set forth above, this ground of rejection should be maintained.

G. Whether the Rejection of Claim 28 under 35 USC 102(b) is Proper?

Appellant again and again semantically alleged that Adams’ components 14, and 21, 6 are not adjusting components and the elements 23 and 13 are not the keyways. The examiner respectfully refers to the explanation on pages 12 and 13 of Paper No. 15 wherein the elements 14 (male member) and 21, 6 (female member) are interpreted as the so-called “adjusting components.”

Contrary to appellant’s understanding, Fig. 1 of Adams shows that the element 14 is telescopic within the elements 21 and 6 in the same manner as appellant’s male and female members. In addition, the recess 23 receives the cogs 13 on the locking sleeve 11 in order to facilitate the rotation of the sleeve 11 as explicitly described in lines 9-21 of column 3. Therefore, the recess 23 and the cogs 13 perform or act in the manner claimed in claim 28.

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Finally, appellant repeated that Adams does not disclose the coil spring to shorten the overall length of the conduit sections. In view of judicial economy, the examiner respectfully refers to the explanation in claims 20 and 21 based on Adams above.

The rejection of claim 28 is, therefore, maintained.

H. Whether the Rejection of Claim 37 under 35 USC 102(b) is Proper?

Appellant again and again semantically alleged that Adams' components 14, and 21, 6 are not adjusting components and the elements 23. The examiner respectfully refers to the explanation regarding claim 28 above.

Appellant further attacked that Adams does not teach a pillar extending into the adjustment components. Contrary to appellant's remarks, Exhibit II attached to Paper No. 15 shows the swivel member having a swivel ball extending into the adjustment components 14 and 21, 6. Therefore, the claimed pillar is "fully met" by Adams' swivel member.

Finally, appellant proposes to amend claim 37 to change "said members" to "said components." However, appellant did not file any formal amendment after final. Therefore, the term "said members" in claim 37 is legally lacked antecedent basis, *a fortiori*, this ground of rejection is legally proper.

I. Whether the Rejection of Claim 38 under 35 USC 102(b) is Proper?

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Appellant reiterated that Adams does not teach the adjusting components, the male and female members having the keyways and the coil spring as claimed. The examiner respectfully refers to the explanation regarding claims 28 and 37 above.

J. Whether the Rejection of Claim 39 under 35 USC 102(b) is Proper?

Appellant reiterated that Adams does not teach the adjusting components, the male and female members having the keyways, the internal limit surface and the coil spring as claimed. The examiner respectfully refers to the explanation regarding claims 28 and 38 above. In addition, the examiner respectfully points out the internal limit surface 16 for engaging an inner end of the pillar (swivel member) as claimed.

K. Whether the Rejection of Claim 40 under 35 USC 102(b) is Proper?

Appellant reiterated that Adams does not teach the adjusting components, the male and female members, and the pillar as claimed. The examiner respectfully refers to the explanation regarding claim 39 above. In addition, the examiner respectfully points out the pillar (i.e., swivel member) of Adams is slidably disposed in the male member 14 via the internal surface 16 as seen in Exhibit II.

Appellant contended that the swivel 40 is fixed to the male member. However, note that in order to insert the swivel member into the sheath 14 (male member), one has to push the swivel head into the male member 14. During the step of pushing, the swivel head of Adams is slid into the male member 14. Therefore, appellant's recitation "being slidably disposed" in claim 40 is "fully met" by

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Adams. On the other hand, it is well settled that the manner of operating the device does not differentiate apparatus claim from prior art if the prior art apparatus teaches all of the structural limitations of the claim. *Ex parte Masham*, 2 U.S.P.Q.2d 1647 (Bd. Pat. App. & Inter. 1987) and M.P.E.P. 2114.

CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Vinh T. Luong
Primary Examiner

Conferees on June 15, 2000:

Primary Examiner Lenard A. Footland and
Primary Examiner Mimi Green.